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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO.       |
|---|-------------|----------------------|------------------------------|------------------------|
| 10/811,824  | 03/30/2004  | Yoshiaki Mimura      | WEN-0032                     | 3065                   |
| 23353 7590 10/26/2007<br>RADER FISHMAN & GRAUER PLLC<br>LION BUILDING<br>1233 20TH STREET N.W., SUITE 501<br>WASHINGTON, DC 20036 |             |                      | EXAMINER<br>PINKNEY, DAWAYNE |                        |
|   |             |                      | ART UNIT<br>2873             | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>10/26/2007      | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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|                              |                                |                               |  |
|------------------------------|--------------------------------|-------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/811,824  | Applicant(s)<br>MIMURA ET AL. |  |
|                              | Examiner<br>DaWayne A. Pinkney | Art Unit<br>2873              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 9-10, 12-14, and 16-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 7, 10, 12-14, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 7, 10, 12, 14, and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Miwa (US 5, 841, 502).

Regarding **claim 7**, Miwa discloses, an ophthalmic apparatus comprising:

an intraocular pressure measurement part including a blowing unit which blows a fluid to a cornea via a nozzle for measuring intraocular pressure of an eye of an examinee (Column 1, lines 13-19, Column 3, lines 63-67 and Column 4, line 1);

an eye characteristic examination part in which an examination optical system, which photo-receives reflection light from the eye for examining an eye characteristic, is arranged (Column 1, lines 9-19);

a main body in which the measurement part and the examination part are arranged (Column 3, lines 21-23 and 1 of Fig. 1);

a mobile base on which the main body is movably arranged (Column 4, lines 11-15 and 3 of Fig. 1);

a first moving unit, having a movement operating member, which moves the mobile base with respect to the eye in a working distance direction through operation of the operating member (Column 3, lines 32-42);

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a second moving unit, which moves the main body with respect to the mobile base in the working distance direction (Column 3, lines 32-42, Column 4, lines 11-15 and 3 of Fig. 1);

a third moving unit which moves the measurement part with respect to the main body in the working distance direction (Column 3, lines 32-42 and Column 3, lines 55-60);

mode switching means for emitting a switching signal to switch between a first mode for examining the eye characteristic and a second mode for measuring the intraocular pressure (inherent);

a detection unit, which detects that the mobile base is located at a rear reference position set in a direction away from the eye with respect to a position of the mobile base at the time of examining in the first mode to emit a detection signal (Column 1, lines 23-27, and Column 9, lines 41-64); and

a movement control unit, which controls driving of the third moving unit so as to move at least a nozzle of the measurement part near to the eye by a predetermined distance with respect to the main body, based on the detection signal of the detection unit obtained after emission of the switching signal from the first mode to the second mode (Column 1, lines 41-45, Column 1, lines 65-67 and Column 2, lines 1-17).

Regarding **claim 10**, Miwa discloses, an ophthalmic apparatus comprising:

an intraocular pressure measurement part including a blowing unit which blows a fluid to a cornea via a nozzle for measuring intraocular pressure of an eye of an examinee (Column 1, lines 13-19, Column 3, lines 63-67 and Column 4, line 1);

an eye characteristic examination part in which an examination optical system, which photo-receives reflection light from the eye for examining an eye characteristic, is arranged (Column 1, lines 9-19);

a main body in which the intraocular pressure measurement part and the eye characteristic measurement part are arranged (Column 1, lines 9-11, Column 3, lines 21-23 and 1 of Fig. 1);

a first moving unit which moves the main body with respect to the eye in the working distance direction (Column 3, lines 32-42, Column 4, lines 11-15 and 3 of Fig. 1);

a second moving unit which moves the intraocular pressure measurement part with respect to the main body in the working distance direction (Column 3, lines 32-42 and Column 3, lines 55-60);

mode switching means for emitting a switching signal to switch between a first mode for examining the eye characteristic and a second mode for measuring the intraocular pressure (inherent); and

a movement control unit, which controls driving of the first moving unit so as to locate the main body once at a rear position in a direction away from the eye, and then controls driving of the second moving unit so as to move at least a nozzle of the measurement part near to the eye by a predetermined distance with respect to the main body based on the switching signal from the first mode to the second mode, and controls the driving of the second moving unit so as to move the measurement part away from the eye based on the switching signal from the second mode to the first mode (Column 1, lines 41-45, Column 1, lines 65-67, Column 2, lines 1-17 and Column 9, lines 41-64).

Regarding **claim 12**, Miwa discloses, the ophthalmic apparatus according to claim 10, further comprising:

a detection optical system, arranged in the main body, for detecting each alignment state of the eye characteristic measurement part and the intraocular pressure measurement part with respect to the eye in the working distance direction (Column 1, lines 23-27); and

judging means for judging appropriateness of the alignment state of the eye characteristic measurement part in the first mode and appropriateness of the alignment state of the intraocular pressure measurement part in the second mode according to a different reference working distance, based on a detection result obtained by the detection optical system (Column 1, lines 41-45, Column 1, lines 65-67, Column 2, lines 1-17 and Column 9, lines 41-64).

Regarding **claim 14**, Miwa discloses, the ophthalmic apparatus according to claim 10, further comprising a working distance detection unit, which detects a working distance of the intraocular pressure measurement part with respect to the eye (Column 1, lines 65-67 and Column 2, lines 1-17),

wherein the movement control unit controls the driving of the second moving unit so as to stop movement of the intraocular pressure measurement part in a direction near to the eye when the detected working distance is less than a reference working distance (Column 1, lines 65-67 and Column 2, lines 1-17).

Regarding **claim 16**, Miwa discloses, the ophthalmic apparatus according to claim 10, further comprising an informing unit, which informs a movement state of the intraocular pressure measurement part (Column 9, lines 49-57).

Regarding **claim 17**, Miwa discloses, an ophthalmic apparatus comprising:

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an eye characteristic examination part in which an examination optical system, which photo-receives reflection light from the eye of an examinee for measuring at least one of eye refractive power and a corneal shape of the eye as an eye characteristic, is arranged (Column 1, lines 6-11, and Column 1, lines 9-19);

an intraocular pressure measurement part including a blowing unit which blows a fluid to a cornea via a nozzle for measuring intraocular pressure of an eye of the eye (Column 1, lines 13-19, Column 3, lines 63-67 and Column 4, line 1), which has a working distance shorter than a working distance which is necessary for measurement by the eye characteristic measurement part (note, that it is inherent that the working distance for intraocular pressure measurement is shorter than the distance that is necessary for measurement by the eye characteristic measurement part because the intraocular pressure measurement part must be as close as possible to the eye without touching it in order to accurately measure the intraocular pressure whereas the eye characteristic measurement part needs to be relatively close to the eye but does not need to be as close to the eye as possible without touching the eye to accurately measure the characteristics of the eye. Furthermore, the intraocular pressure measurement has to be closer to the eye in order for this measurement to work, this is due to the fact that the cornea will not deform enough for this measurement to be accurately performed.)

a main body in which the intraocular pressure measurement part and the eye characteristic measurement part are arranged (Column 1, lines 9-11, Column 3, lines 21-23 and 1 of Fig. 1);

a first moving unit which moves the main body with respect to the eye in the working distance direction (Column 3, lines 32-42, Column 4, lines 11-15 and 3 of Fig. 1);

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a second moving unit which moves the intraocular pressure measurement part with respect to the main body in the working distance direction (Column 3, lines 32-42 and Column 3, lines 55-60);

mode switching means for emitting a switching signal to switch between a first mode for examining the eye characteristic and a second mode for measuring the intraocular pressure (inherent); and

a movement control unit, which controls driving of the second moving unit so as to move at least a nozzle of the intraocular pressure measurement part near to the eye by at least a distance shorter than the working distance of the eye characteristic measurement part with respect to the main body based on the switching signal from the first mode to the second mode (Column 1, lines 41-45, Column 1, lines 65-67, Column 2, lines 1-17 and Column 9, lines 41-64).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miwa (US 5, 841, 502) as applied to claim 12 above.

The cited primary reference, Miwa, remains as applied to **claim 12 above**.

The cited primary reference does not teach a reference working distance in the first mode and the reference working distance in the second mode have a different permissible range.



It would have been obvious to one of ordinary skill in the art at the time the invention was made that the first and second modes have reference working distances that have a different permissible range because the second mode (intraocular pressure measurement) has to be closer to the eye in order for this measurement to work, this is due to the fact that the cornea will not deform enough for this measurement to be accurately performed.

***Response to Arguments***

5. Applicant's arguments filed 08/09/2007 have been fully considered but they are not persuasive.

6. In response to applicants arguments that Miwa does not disclose any techniques for switching in consideration of a position of a main body of the apparatus with respect to the examinee's eye at the time of switching of a measurement system. Examiner points out that inherently that the apparatus of Miwa teaches techniques for switching in consideration of a position of a main body of the apparatus with respect to the examinee's eye at the time of switching a measurement system since the apparatus of has the functions of taking intraocular pressure measurements and eye characteristic measurements (Column 1, lines 6-11), since the apparatus performs more than one measurement, there must be a switching technique employed in the apparatus so that the apparatus will have the ability to switch from measuring intraocular pressure to measuring characteristics of the eye (refractive power of the eye). The two different measurements of Miwa have reference working distances that have a different permissible range since the intraocular pressure measurement has to be closer to the eye in order for this measurement to work, this is due to the fact that the cornea will not deform enough for this measurement to be accurately performed. Furthermore, the working distance for intraocular

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pressure measurement is shorter than the distance that is necessary for measurement by the eye characteristic measurement part because the intraocular pressure measurement part must be as close as possible to the eye without touching it in order to accurately measure the intraocular pressure whereas the eye characteristic measurement part needs to be relatively close to the eye but does not need to be as close to the eye as possible without touching the eye to accurately measure the characteristics of the eye. Therefore, Miwa teaches techniques for switching in consideration of a position of a main body of the apparatus with respect to the examinee's eye at the time of switching a measurement system.

*Allowable Subject Matter*

7. Claims 1-6 are allowed.
8. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. The following is an examiner's statement of reasons for allowance: none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, in reference to independent claim 1, none of the prior art either alone or in combination disclose or teach of the claimed ophthalmic apparatus specifically including, as the distinguishing feature(s) in combination with the other limitations the claimed "a reflection member, having a reflection surface, which is arranged insertably and removably between the eye and the nozzle."

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

10. The following is a statement of reasons for the indication of allowable subject matter: none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, in reference to dependent claim 9, none of the prior art either alone or in combination disclose or teach of the claimed ophthalmic apparatus specifically including, as the distinguishing feature(s) in combination with the other limitations the claimed "a reflection member, arranged insertably and removably between the eye and the nozzle, for guiding the reflection light from the eye to the examination optical system."

### *Conclusion*

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

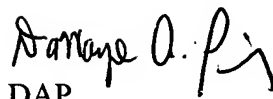
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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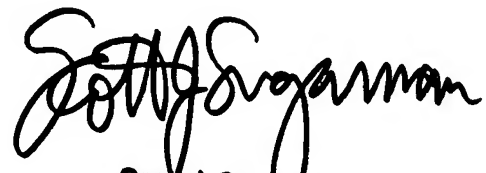
Any inquiry concerning this communication or earlier communications from the examiner should be directed to DaWayne A. Pinkney whose telephone number is (571) 270-1305. The examiner can normally be reached on Monday-Thurs. 8 a.m.- 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DAP  
10/20/2007

  
Scott J. Sugarman  
Primary Examiner